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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|---|---|-------------------------------|
| Applicant: Patrick H. Potega, Pro Se |) | RE: RESPONSE TO OFFICE |
| |) | ACTION |
| |) | |
| Serial No.: 09/475,946 |) | Date: 27 August 2003 |
| |) | |
| Filed: 31 December 31 1999 |) | Examiner: Thuan N. Du |
| |) | |
| For: "HARDWARE FOR CONFIGURING AND DELIVERING POWER" |) | Group Art Unit: 2185 |
| |) | |

Mr. Derek L. Woods, Esq.
ATTN: Office of Petitions
Mail Stop PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTN: Mr. Derek L. Woods

Response to Office Action – Election Restriction

Sir:

This is in response to the Office Action mailed 9 September 2002.

Applicant is required to elect a single disclosed species for the invention. Pursuant to 35 U.S.C. 121, should prosecution of the subject application result in generic Claims 1-5 not being finally held to be allowable on their merits, applicant hereby elects with traverse,

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and without prejudice, Claims 6-9 as a patentably distinct species of the claimed invention.

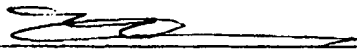
Applicant is available by phone at (818) 340-7268, or by FAX (818) 887-3197.

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Respectfully submitted,



Patrick Potega
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7021 Vicky Avenue
West Hills, CA 91307-2314

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail # EU662600893US in an envelope addressed to: ATTN: Mr. Derek L. Woods, Esq., Office of Petitions, Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

27 AUGUST 2003

(Date of Deposit)

PATRICK H. POTEGA

(Name of Applicant, Assignee or Registered Representative)



(Signature)

8/27/03

(Date)

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|--------------------------------------|---|-------------------------------------|
| Applicant: Patrick H. Potega, Pro Se |) | RE: REQUEST FOR RECONSIDERA- |
| |) | TION OF PETITION TO REVIVE |
| |) | FOR PATENT ABANDONED |
| |) | UNAVOIDABLY |
| |) | |
| Serial No.: 09/475,946 |) | Date: 27 August 2003 |
| |) | |
| Filed: December 31, 1999 |) | Examiner: Thuan N. Du |
| |) | |
| For: "HARDWARE FOR CONFIGURING |) | Group Art Unit: 2185 |
| AND DELIVERING POWER" |) | |

Mr. Derek L. Woods, Esq.
Attention: Office of Petitions
Mail Stop PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Request For Reconsideration Of Petition Under 37 CFR 1.137
To Revive For Patent Abandoned Unavoidably

Mr. Woods:

This Request For Reconsideration Of Petition is in reply to the Office's initial response, mailed 31 July, 2003. Applicant's original Petition To Revive For Patent Abandoned Unavoidably (mailed 11 July 2003) relates to Application # 09/475,946 titled "Hardware for Configuring and Delivering Power" as filed on 31 December 1999, went abandoned because applicant allegedly failed to timely file a proper reply to the Office letter mailed 9 September 2002. Applicant herewith encloses a copy of the original petition.

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Applicant requests the Commissioner to reconsider the petition to revive the application that was abandoned unavoidably, because:

1) Applicant's basis for failing to timely file a proper reply to the Office letter, as stated in Paragraphs 11-15 of the original petition, deserve reasonable reconsideration. As stated in the petition, Applicant was contacted by the Examiner on 3 October 2002 with a request to file by telefax a Change of Correspondence Address, so that applicant could receive the subject Office letter. Applicant responded to the Examiner in a proper and timely manner, and in compliance with 37 C.F.R. § 1.33(a), by faxing a change of correspondence address to the Examiner that day. Please note the Auto-Reply Facsimile Transmission as attached Exhibit J of the original petition, which clearly confirms that applicant's change of correspondence address was duly received by the Office. As of that date, some 6 days remained prior to the expiration of the 1-month shortened statutory period for applicant's reply which, had applicant received the agreed upon Office letter, allowed sufficient time for applicant to file a proper reply.

Further, had Applicant's filing of a proper change of correspondence address on 3 October 2002 resulted in a applicant receiving the instant Office letter at any time during the next 4 months, there was still sufficient time for applicant to properly reply, since the entirety of the 5-month maximum extend-able time period remaining under 37 C.F.R §1.136(a).

Given that the matter of the subject Office letter which applicant finally received on 9 May 2003 was a straight-forward election/restriction, applicant's proper reply could have been a prompt verbal response, or even a fax response the same day the Office letter was received -- before the shortened statutory deadline of 9 October 2002, and certainly before the final extend-able deadline of 9 March 2003.

Instead, applicant was not contacted by the Office until 29 April 2003 -- well after any allowable extensions to reply -- only to be informed that the Examiner had never received the Change of Correspondence Address faxed on 3 October 2002. Further, applicant's re-faxing of several Change of Correspondence Address notices on 29-30 April 2003 were also not received by the Examiner, and only the fourth submission of a Change of Correspondence Address by fax on 9 May 2003 resulted in applicant being sent the subject Office letter of 9 September 2002 (see Exhibits K, L, M, and N of the original petition).

As the original petition and attached exhibits indicate, applicant's prompt and repeated filings of change of correspondence address were a *bona fide* attempt to advance the application. Also, applicant had performed in sufficient time to have received the subject Office letter prior to the either/both the initial non-extended and extend-able deadlines for filing a reply. Also, given that applicant was not informed that his first Change of Correspondence Address was not in possession of the Examiner until a month after applicant's final extend-able deadline to reply, applicant could not have reasonably foreseen the events, nor anticipated the outcome of avoiding not filing a timely reply. Therefore, applicant requests reconsideration of the subject petition to revive for the patent abandoned unavoidably.

2) Applicant brings to the Commissioner's attention that the original petition does indicate in Paragraph 5 that the Examiner did have a phone communication with Mr. Hollingsworth. Because Mr. Hollingsworth had filed a Request to Withdraw as Attorney of Record, it was proper for the Examiner to contact applicant in the above-cited request for a change of correspondence address. Even though Mr. Colin Abraham's address was incorrectly still of record (because Mr. Abraham's failed to file his Request to Withdraw as Attorney of Record), 37 C.F.R. § 1.33(a) states that, if more than one correspondence address is specified, the Office will establish one as the correspondence address. Thus,

the Examiner's phone call to applicant on 3 October 2002 was certainly a reasonable way to establish applicant's address as the valid one.

3) The Office has averred two things¹:

First, that the USPTO does not send more than one document. If this is correct, then by the Office having sent the subject Office letter to Mr. Abrahams on 9 September 2002, applicant's reasonably prudent action of submitting not only the first, but any whatsoever of the multiple resubmissions of same as described in the original petition, would not have changed the inevitable outcome of not receiving the subject Office letter, because of this limitation on the number of documents that the Office can send. Therefore, even applicant's actions in repeatedly submitting a change of address could not have avoided the failure to reply.

Second, the Office also avers that, similarly, an examiner is under no obligation to send an applicant any documents and that, should an examiner do so, such action would be only out of personal consideration. Here also, such a situation as applicant's on 3 October 2002, when the Examiner requested applicant to submit a change of address, could only lead to a circumstance of which the outcome could not ordinarily have been anticipated by applicant, i.e., that the expected Office letter would not be sent. Thus, even though applicant acted reasonably and prudently, the above cited issues inevitably caused an unanticipated outcome beyond applicant's ability to prevent or avoid.

4) The 31 July 2003 reply to applicant's original petition states that applicant is bound by the consequences of the actions or inactions of applicant's "duly authorized and voluntarily chosen representatives." However, applicant's petition clearly indicates that, as of the 9 September 2002 mailing date of the subject Office letter, neither Mr.

¹ In phone communications with the Office on 19 and 25 August, 2003.

Hollingsworth nor Mr. Abrahams were duly authorized by applicant to act on applicant's behalf, nor could they in any way be considered applicant's representatives. As the original petition shows, because these attorneys had dissociated themselves from applicant over a year prior to September 2002, they were not under applicant's control or even influence, therefore applicant should not be bound by their actions or inactions. The events described in applicant's original petition clearly establish a basis for unavoidability, in that:

- No reasonable prudence or foresight on applicant's part could have prevented the attorneys' not under the control of applicant from failing to perform their normally anticipated action of properly withdrawing, especially Mr. Abraham's withdrawals from all PCT actions, but then failing to withdraw from PTO actions. This event, in an environment of attorneys having dissociated themselves, could not have been anticipated by a reasonably careful applicant in similar circumstances, and the results of which applicant could neither prevent or avoid.
- Without the benefit of hindsight as to attorney's actions or inactions at the time that the subject Office letter of 9 September 2002, and especially without applicant having any information or knowledge of those actions or inactions at the time of the mailing of the Office letter, applicant's situation of being unaware of the causative events leading up to applicant's non-receipt of the Office letter clearly points to applicant's obvious inability to reasonably foresee or anticipate the circumstances and events described in the original petition. Without any ability to foresee or anticipate the circumstances and events, applicant could not have in any way prevented neither those circumstances or events, nor the effect of being unable to avoid not properly responding to the Office letter.
- As of applicant's prior attorneys' dissociation in April 2001 -- over a year prior to the instant Office letter -- applicant had no contractual or other binding constraints

over the actions or inactions of his prior counsel. This applies to applicant's unavoidably failing to respond to the instant Office letter by:

- ◆ The Office's response to applicant's original petition (mailing date 31 July 2003) cites the basis for dismissal as "unavoidable because of the actions or inactions of his Attorneys." This finding is not supported by the facts as put forth in applicant's original petition, wherein distinctly and repeatedly applicant asserts that Messrs. Hollingsworth and Abrahams were not in any capacity acting as applicant's attorneys.
- ◆ Further, the response states that "Applicant is advised that the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions." As has been reiterated here from the facts presented in the original petition, neither Messrs. Hollingsworth or Abrahams were contractually or otherwise "duly authorized" by applicant during any time period relevant to the subject Office letter. The events and circumstances described in the original petition portray anything but these prior counsels' being "representatives" of applicant. As previously brought forth herein, one result of the dissociation of these prior attorneys from client was that any obligations (contractual or otherwise) which previously may have bound applicant to their actions or inactions were removed over a year prior to the mailing of the subject Office letter, so this basis for dismissal merits reconsideration through its lack of support from the facts presented in the original petition.
- ◆ The events and applicant's circumstances put forth in applicant's original petition were not ordinary. Instead, the events and situations as described in the original petition were far from ordinary. For example, ordinarily a

dissociated attorney would file a Request For Withdrawal, and applicant would receive proper notice in due course. But, in applicant's situation, the prior counsel whose mailing address was of record with the PTO filed with all other agencies except the PTO. By this example and others like it throughout the original petition, there is a clear picture of events that were sufficiently unordinary that any reasonably prudent applicant in like circumstances would not ordinarily anticipate, and whose effects, under similar circumstances, such applicant would not ordinarily avoid.

Therefore, the above reasoned arguments, in conjunction with the information presented in applicant's original petition, constitute the bases for this request for reconsideration of the petition, with the best hope and expectation that the Commissioner revives the subject application, so as to allow applicant to continue the prosecution thereof.

Applicant is herewith filing the attached reply to the Office letter, thereby correcting the cited deficiency in applicant's original petition.

Applicant can be contacted by phone at (818) 340-7268, or by FAX (818) 887-3197.

Please acknowledge receipt hereof by stamping and returning the enclosed return postcard.

Respectfully submitted,



Patrick H. Potega
Applicant, Pro Se
7021 Vicky Avenue
West Hills, CA 91307-2314

Enclosed:

Transmittal Form

Reply to 9 September 2002 Office Action

Copy of Original Petition (mailed 11 July 2003)

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27 August 2003

(Date of Deposit)

PATRICK H. POTEGA

(Name of Applicant, Assignee or Registered Representative)



(Signature)

8/27/03

(Date)